

MPEP 809.02(a) sets forth action to be taken by the Examiner under an election requirement, that action includes:

- 1) "Identify generic claims or indicate that no generic claims are present."

The Examiner has stated that "Currently, all the claims appear generic or subgeneric," whatever the term "subgeneric" means.

- 2) "Clearly identify each (or in aggravated cases at least exemplary ones) of the disclosed species, to which claims are restricted."

The Examiner has failed to identify any species as required.

The Examiner then states:

"This requirement is on the basis of Markush practice and/or unduly broad claims, MPEP 803.02 and 809.02(d)."

A review of Claims 1 and 26-45 shows that there are no Markush claims and that with the exception of Claims 1 and 26, the claims cannot be reasonably construed as "unduly broad."

On page 3 of the Office Action, the Examiner states:

"Should applicant elect a generic embodiment that could include additional steps, e.g., applicant will be required to maintain the original election, *per se*, without change."

The Examiner is called upon to explain how an elected species can constitute "a generic embodiment." Does this statement mean, for example, that if an embodiment constituting steps A, B, and C was elected, a claim could not be accepted if it included steps A, B, C and D? It appears that the Examiner intends by this statement to limit an applicant to a single claim which only covers elected steps A, B, and C, for example. If so, such is clearly improper.

The Examiner then states:

"That is, applicant will not be permitted to shift to a more limited, e.g., different species."

It is recognized that a shift in an election of species to a "different species" is impermissible. It appears that the Examiner contends that the applicant must elect the most limited species. Thus, only a single claim to that most limited species would be acceptable. Is so, the Examiner's contention is clearly inconsistent with established Office practice, and there is no known authority to support this very limited approach.

Next, the Examiner states:

"Claims that are further limitations of an ostensible 'elected species' (genus) will, for purposes of examination, not read on the elected 'single species.' See also MPEP 819."

Since when is an "elected species" a "(genus)"? What does this statement mean?

Apparently, it means that the Examiner will limit the claims to only the "elected species." What about the generic claims, would they not be examined?

Since the Examiner has failed to identify any species, as required by MPEP 809.02(a), and has stated that: "Currently, all the claims appear generic or subgeneric," it is impossible for Applicant to make an election of "a single disclosed species" nor can Applicant identify which claims read on such "a single disclosed species." Accordingly, the Examiner is called up to set forth an election of species requirement that complies with MPEP 809.02(a). The burden of identifying the species lies with the Examiner, not with the Applicants. Also, it is requested that the Examiner clarify the meaning of the various above quoted statements, including what constitutes a "subgeneric" claim.

Dated: 10/20/00

Respectfully submitted,



L.E. Carnahan

Agent for Applicant
Registration No. 20,555
Tel. No. (925) 422-5024